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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,814	03/09/2004	M. Michael Pitts JR.	111732.00012	2055
34282	7590	11/16/2005	EXAMINER	
QUARLES & BRADY STREICH LANG, LLP ONE SOUTH CHURCH AVENUE SUITE 1700 TUCSON, AZ 85701-1621			LEADER, WILLIAM T	
		ART UNIT		PAPER NUMBER
				1742

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4/

Office Action Summary	Application No.	Applicant(s)	
	10/796,814	PITTS ET AL.	
	Examiner	Art Unit	
	William T. Leader	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 August 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Receipt of the papers filed on August 31, 2005, is acknowledged. Claims 1-3 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Pitts, Jr. patent number 5,591,317 for the reasons set forth in the previous office action and in view of the following comments.
4. Applicant's Remarks have been carefully considered but are not persuasive. As stated in MPEP 2133.01, when an applicant files a continuation-in-part whose claims are not supported by the parent application, the effective filing date is the filing date of the child CIP, and any prior art disclosing the invention having a reference date more than 1 year prior to the filing date of the child will bar the issuance of a patent under 3 U.S.C. 102(b). The claims of the instant application are not considered to be supported by the disclosure of 08/197,154 which issued as patent 5,591,317. While the '154 patent discloses the same electrostatic field generator used in the instant method, the '154 application does not disclose a

method for reducing the formation of biofilm deposits on a wall in a water system.

Other than immediate parent application 10/047,493 filed on January 14, 2002, none of the other applications in the priority chain disclose a method for reducing the formation of biofilm deposits on a wall in a water system. Thus, the effective filing date of the instant application is January 14, 2002. The Pitts, Jr. '317 patent issued on January 7, 1997, more than one year prior to the effective filing date of the instant application and is considered to be a reference against the instant claims.

5. Applicant argues that even if claims 1-3 were not supported by the disclosure of the '317 patent, this patent still cannot anticipate the present application because a lack of supporting disclosure means that one or more elements of claims 1-3 must be missing from the '317 patent. As noted above, applicant's claims are directed to a method for reducing the formation of biofilm deposits. The claims do not require that an initial biofilm be present. They require only that the formation of biofilm deposits be reduced. The use of the electrostatic field generator disclosed and claimed in the '317 patent is considered to inherently result in reducing the formation of biofilm deposits.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 571-272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WL
William Leader
November 7, 2005

ROY KING
SUPERVISORY EXAMINER
TECHNOLOGY CENTER 1700